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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,458	07/18/2000	Eiji Hayashi	862.C1958	8847

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NEW YORK, NY 10112

EXAMINER

CHAU, MINH H

ART UNIT PAPER NUMBER

2854

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,458

Applicant(s)

HAYASHI, EIJI

Examiner

Minh H Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57,58,60-65,67-72,74-79 and 81-84 is/are rejected.
- 7) ☒ Claim(s) 59,66,73 and 80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/09/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 57, 58, 60-62, 64-65, 67-69, 71, 72, 74-76, 78, 79 and 81-83** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani (US # 6,144,818) in view of Bigi (US Pub. # 2002/0085223 A1).

With respect to claims 57, 64, 71 and 78, Ohtani teach a host computer (2), a machine readable storage medium, a computer program and a method for communicating with a printer device (1) having stapling function (col. 2, line 48) for binding together a plurality of sheets, generating a print data suited to the printer device, and transmitting the print data to the printer device, comprising acquisition means for acquiring paper feed tray information concerning the printer device from the printer device to which the print data is actually transmitted (col. 3) and display control means for controlling a screen display concerning the setting of staplable positions on the basis of the paper feed tray information acquired by the acquisition means from the printer device to allow the user from selecting the unstaplable positions on a printing paper in a paper feed tray of the printer device(see Fig. 1-9 and cols. 2-5 of Ohtani).

Ohtani teach all the limitation as explained above, except for the paper feed tray information is acquired "before the print data is transmitted to the printer device".

Bigi teaches a system and methods for printing documents and for selecting staple positions for printed document including acquisition means for acquiring paper feed tray information concerning the printer device before the print data is transmitted to the printer device (see paragraph [0051 – 0058] of Bigi).

In view of this teaching, it would have been obvious to one of skill in the art to modify the device and method of Ohtani to include the acquisition means for acquiring paper feed tray information concerning the printer device before the print data is transmitted to the printer device as taught by Bigi for the advantage of allowing the user to select a proper settings for the feeding direction and the stapling position in accordance to the paper types or sizes.

With respect to claims 58, 65, 72 and 79, see cols. 2-3 and Figs. 6-10 of Ohtani that teach the paper feed tray information relates to the size and the feeding direction of the printing paper or the R/non-R information of the printing paper and the display control means for displaying the setting of staplable positions on the basis of the R/non-R information and the paper size information.

With respect to claims 60, 67, 74 and 81, see cols. 2-3 and Figs. 6-10 of Ohtani that teach the display control means controls the screen display concerning the setting of staplable positions on the basis of the paper feed tray information acquired by the acquisition means.

With respect to claims 61, 68, 75 and 82, see cols. 3-4 of Ohtani that teach a size of the printing paper that has been actually located in the paper feed tray is determined on the basis of the paper feed tray information acquired by the acquisition means.

With respect to claims 62, 69, 76 and 83, see col. 3 of Ohtani that teach the setting means or a manual setting means for setting a desired paper size or the R/non-R information concerning the printing paper by using a user interface and the acquisition means acquires the R/non-R information and the paper size information on the printing paper by the setting means or manual setting means as the paper feed tray information.

3. **Claims 63, 70, 77 and 84** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani and Bigi as applied to claims 57, 58, 60-62, 64-65, 67-69, 71, 72, 74-76, 78, 79 and 81-83 above, and in view of Kimoto et al (US # 5,390,005).

With respect to Claims 63, 70, 77 and 84, the combined device and method of Ohtani and Bigi teach all the limitation as explained above, except for the recitation of "paper feed tray information is set by using a control panel on the printer device".

Kimoto et al. Teach an image-forming machine including paper feed tray information is set by using a control panel on the an image-forming machine (see Fig. 5 and col. 5, lines 59+ of Kimoto et al.)

In view of this teaching, it would have been obvious to one of skill in the art to modify the combined device and method of Ohtani and Bigi to including the paper feed tray information is set by using a control panel on the image-forming device as taught by Kimoto et al. so that to allow the user to selects and set a kinds of sheet and a sheet size that are actually loaded in the paper feed tray as the printing device.

Allowable Subject Matter

4. **Claims 59, 66, 73 and 80** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Remarks

5. Applicant's arguments with respect to claims 57, 64, 71 and 78 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

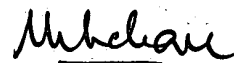
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H Chau whose telephone number is (571) 272-2156. The examiner can normally be reached on M - TH 9:30AM - 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHC
May 15, 2004



Minh Chau
Patent Examiner